

## REMARKS

In the Office Action dated April 6, 2005, the Examiner objected to claim 50 as improperly depending on later dependent claim 51. The Examiner also rejected claims 3, 45, and 46 under 35 U.S.C. § 112, Second paragraph. The Examiner also rejected claims 1, 3-10, 32, 33, 36, 37, 39, 44-49 under 35 U.S.C. § 102(b) as being anticipated by Brockman (U.S. Patent No. 5,884,300); and rejected claims 11, 42, 43, 50, and 51 under 35 U.S.C. § 103(a) as being unpatentable over Brockman in view of *Official Notice*. Finally, the Examiner rejected claims 34, 35, 40, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Brockman in view of Hoblit et al. ("Hoblit") (U.S. Patent Application No. US 2002/0072977). While claim 52 was not specifically addressed in the Office Action, the Examiner, in a telephonic conversation with the applicant's representative on June 20, 2005, indicated that claim 52 should be added to the above-mentioned 35 U.S.C. § 102(b) rejection. Therefore, applicant will address the rejection of claim 52 under 35 U.S.C. § 102(b) as being anticipated by Brockman.

Applicant wishes to thank the Examiner for speaking with Applicant's representatives during an interview on June 28, 2005. The remarks presented below are consistent with the topics discussed during the interview.

Claims 1 and 3-52 are pending in this application with claims 1, 12, 18, 37, and 52 being the independent claims. Claims 12-31 and 38 had been previously withdrawn from consideration. Claims 1, 3, 5, 6, 32, 37, 45, 46, and 49-52 have been amended in this application.

### **Claim Objections**

Claim 50 has been amended so that it properly depends from claim 49.

Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to claim 50.

### **Rejections under 35 U.S.C. § 112**

Claims 3, 45, and 46 have been amended in accordance with the Examiner's suggestions. Therefore, Applicant respectfully requests that the Examiner withdraw the Section 112, Second paragraph rejections to claims 3, 45, and 46.

### **Rejections under 35 U.S.C. § 102(b)**

Applicants respectfully traverse the rejection of claims 1, 3-10, 32, 33, 36, 37, 39, 44-49, and 52 under 35 U.S.C. § 102(b) as being anticipated by Brockman because Brockman fails to disclose every claim element. For example, independent claim 1 recites a combination of steps, including, *inter alia*, "establishing a plan . . . , the plan including a change to current inventory practices including one or more of adding an inventory process, modifying an inventory process, or deleting an inventory process; and implementing the change to correct the at least one discrepancy." Brockman fails to disclose at least these claim elements.

In the Office Action, the Examiner maintained that Brockman discloses a method for improving records of inventory, the method including a combination of steps, *inter alia*, identifying discrepancies and generating a management report to alert management to possible problem areas in the inventory model. See Office Action at page 4 (citing Brockman, S430, S435; and column 1, lines 37-42, "self correcting").

While Brockman discloses identifying discrepancies and generating a management report to alert management, it does not disclose “establishing a plan to correct the at least one discrepancy . . . , the plan including a change to current inventory practices including one or more of adding an inventory process, modifying an inventory process, or deleting an inventory process; and implementing the change to correct the at least one discrepancy,” as required by claim 1.

Brockman also fails to disclose every element of independent claim 37. For example, independent claim 37 recites a combination of steps, including, *inter alia*, “assessing at least one inventory record associated with the facility, said record being associated with a *claim received from an external party*, such claim being associated with a part shipment, . . . and changing an inventory practice in response to said record discrepancy and said analysis, the change including one or more of adding an inventory process, modifying an inventory process, or deleting an inventory process.” Brockman fails to disclose at least these elements. In the Office Action, the Examiner maintained that Brockman discloses a “claim” (see Office Action, citing Brockman, Fig. 2 and S435). However, the “claim” disclosed by Brockman is a management report generated by the inventory management system (see Brockman, column 3, lines 12-16) and not a “claim received from an external party,” as required by claim 37.

Independent claim 52, although different in scope, includes elements corresponding to the elements of at least one of claims 1 and 37. Therefore, independent claim 52 is allowable for at least the reasons discussed above. Dependent claims 3-10, 32, 33, 36, 39, and 44-49 ultimately depend on one of claims 1 and 37 and, therefore, are allowable for at least the reasons discussed above.

### **Rejections under 35 U.S.C. §103 (a)**

Applicants respectfully traverse the rejections of claims 11, 42, 43, 50, and 51 under 35 U.S.C. § 103(a) as being unpatentable over Brockman in view of *Official Notice*.

Claim 11 is allowable at least due to its dependence from claim 1, which is allowable for the reasons set forth above. Furthermore, Applicant respectfully traverses the Examiner's taking of Official Notice without providing documentary evidence to support his assertions. As noted in M.P.E.P. § 2144.03, Official Notice unsupported by documentary evidence must include a "clear and unmistakable" technical line of reasoning underlying the decision to take such notice. The unsupported Official Notice taken in the Office Action does not provide such a line of reasoning. For example, the Examiner takes Official Notice of "defining a population of inventory items to count, the population of inventory items to count being less than a total number of inventory items" and "extrapolating the comparison to the total number of inventory items to achieve an inventory count." See Office Action, at page 5, ¶ 9. However, there may be instances where, for example, as disclosed by Brockman, an inventory management system may merely calculate model inventory values (see Brockman, column 3, lines 55-65; and column 4, lines 1-25), which values may be less than a total number of inventory items, but not extrapolate the comparison to the total number of inventory items, because an extrapolation of results obtained from a comparison using a model may not be accurate. To clarify any Official Notice taken by the Examiner, Applicant requests that the Examiner either cite a competent prior art reference or else withdraw the rejections based upon the alleged Official Notice.

Claim 42 is allowable at least due to its dependence from claim 37, which is allowable for the reasons set forth above. Furthermore, as discussed above, Applicant respectfully traverses the Examiner's taking of Official Notice without providing documentary evidence to support his assertions. For example, the Examiner takes Official Notice of a step of "reorganizing at least a portion of said inventory" that "includes the step of relocating said part type in inventory in response to said claim analysis." See Office Action at page 6. However, it is not clear if it was well known in the art to relocate problem prone parts. There may be other ways besides relocating a part to deal with a problem prone part. For example, a manager may decide to supervise one or more persons handling the problem prone part instead of relocating the problem prone part. To clarify any Official Notice taken by the Examiner, Applicant requests that the Examiner either cite a competent prior art reference or else withdraw the rejections based upon the alleged Official Notice.

Claim 43 is allowable at least due to its dependence from claim 1, which is allowable for the reasons set forth above. Furthermore, Applicant respectfully traverses the Examiner's taking of Official Notice without providing documentary evidence to support his assertions. For example, the Examiner takes Official Notice of "identifying and recovering lost inventory in response to said at least one discrepancy." It is unclear how it was well known in the art to identify and recover lost inventory in response to a discrepancy. A system may, upon finding a discrepancy, instead of attempting to identify and recover inventory, generate a plan to increase the inventory, where the plan may include increasing production. In fact, Brockman discloses such a plan. See Brockman, column 2, lines 27-35. To clarify any Official Notice taken by the Examiner,

Applicant requests that the Examiner either cite a competent prior art reference or else withdraw the rejections based upon the alleged Official Notice.

Claims 50 and 51 are allowable at least due to their dependence from claim 1, which is allowable for the reasons set forth above. Furthermore, Applicant respectfully traverses the Examiner's taking of Official Notice without providing documentary evidence to support his assertions. For example, regarding claims 50 and 51, the Examiner takes Official Notice of "analyzing said claim in response to a claim history of said claimant." See Office Action at page 7. However, it is unclear whether it was well known in the art to review a claimant's claim history. For example, it may not be possible for an inventory management system to review a claimant's claim history unless there is a system in place to store a claimant's claim history. To clarify any Official Notice taken by the Examiner, Applicant requests that the Examiner either cite a competent prior art reference or else withdraw the rejections based upon the alleged Official Notice.

Claims 34, 35, 40, and 41 depend from and add additional features to independent claims 1 and 37. Moreover, Hoblit, relied on for its disclosure of inventory analysis based on theft prone or problem prone inventory (see Office Action at page 7, ¶ 10), fails to cure the deficiency of Brockman. Accordingly, claims 34, 35, 40, and 41 are allowable for at least the reasons set forth above.

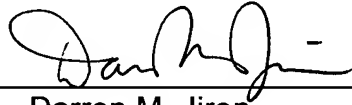
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 5, 2005

By:   
Darren M. Jiron  
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**Attachments:** Three sheets of a copy of a Revocation of Power of Attorney with a New Power of Attorney and Change of Correspondence Address.